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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/415,986	10/12/99	SITRICK	D STD-1748

QM32/0615

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EXAMINER
SAGER, M

ART UNIT	PAPER NUMBER
3713	3

DATE MAILED: 06/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/415,986

Applicant(s)
Sitrick

Examiner
Sager

Art Unit
3713



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 26, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above, claim(s) 1-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

MARK SAGER
PRIMARY EXAMINER

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Restriction/Election of Species

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I, claims 1-5 for user image integration system,

Species II, claims 6-10, for user image integration system,

Species III, claims 11-24, for user image integration method and system, and

Species IV, claims 25-34, for method and system for integrating data into a predefined source..

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there is *no* generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Mr. David Sitrick (29,349) on June 7, 2001 a provisional election was made with traverse to prosecute the invention of Species IV, claims 25-43. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Priority

3. The instant application claims priority as a divisional to a plurality of applications and one of which is a CIP application, 08645678, to the another of the cited applications, 07877715, to which the instant application is a divisional. Clarification for the record concerning priority of the instant application as a divisional to an application 08645678, which is a CIP of the grandparent 07877715, and where the instant application is also a divisional of the grandparent is requested. Finally, **no** restriction requirement or election of species were held in either applications 08645678 or 09184600; however, an applicant may claim appropriate priority for self-elected inventions.

Information Disclosure Statement

4. The cover letter attached to IDS received Feb. 26, 2001 indicates references were cited in an International Search Report; however ISR was not provided.

Drawings

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "380" has been used to designate both scanner (48:7) and interface (48:9). Correction is required.

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed functional steps (clms 25-34) including 'providing user data', 'providing a predefined source', 'selecting a portion of the audiovisual program content', 'integrating the user data with the selected portion' and providing a modified output' and other steps claimed must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. This is neither a written description nor an enablement issue, but rather it pertains to a rule for illustrating to the public the claimed invention.

Claim Objections

7. Claims 25-43 are objected to because of the following informalities: The phrase 'other program data' (clms 25, 28, 35 and 37) is unclear with respect to scope of disclosed invention. Essentially, the phrase fails to clearly define for the public the scope of invention with respect to disclosure. Appropriate correction is required.

Specification

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: tinting (clms 32, 41), adjusting hue (clms 32, 41).

9. The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

© In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because the specification as originally filed in parent application(s), does not provide support for the invention as now claimed. Specifically, the specification does not provide support for rotating (clms 30, 39), skewing (clms 30, 39), resampling (clms 30, 39), morphing (clms 32, 41), adding appearance of film grain (clms 32, 41), adjusting contrast (clms 32, 41), Mercatur projection (clms 33, 42), geometric model (clms 33, 42), geometric mesh (clms 33, 42), keyframe (clms 33, 42), morphing coordinate points (clms 33, 42 and 34, 43), geometric constraint information (clms 33, 42), rotation information (clms 34, 43), film stock identification (clms 34, 43), compositing information (clms 34, 43), masking information (clms 34, 43), motion vector (clms 34, 43), aspect information (clms 34, 43), field of view information (clms 34, 43) and depth of field (clms 34, 43). Further, the specification provides support for controlling lighting for adjusting brightness as demonstrated by description for fig. 5B; however, the specification does not provide support for adjusting brightness pertaining to a graphical modification which involves the manipulation of images.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 32-34 and 41-43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as originally filed, fails to provide support for the invention as now claimed regarding rotating, skewing, resampling, morphing, adding appearance of film grain, adjusting contrast, Mercatur projection, geometric model, geometric mesh, keyframe, morphing coordinate points, geometric constraint information, rotation information, film stock identification, compositing information, masking information, motion vector, aspect information, field of view information and depth of field (*supra*). The originally filed specification fails to provide a written description supporting such processing.

12. Claims 32 and 41 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for adjusting brightness being controlling lighting as described with respect to fig. 5B (*supra*), does not reasonably provide enablement for adjusting brightness or adjusting contrast as a graphical modification as claimed (*supra*). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims. Specifically, the disclosure, as originally filed, supports adjusting brightness with respect to controlling the lighting in a booth as described with description for fig. 5B; however, the specification does not support adjusting contrast or adjusting brightness as a graphical modification.

Double Patenting

13. Applicant is required to maintain a clear line of demarcation between this instant application and copending applications 09184600 and 09416233. See MPEP § 822.

14. Claims 25-43 of this application conflict with claims 67-71 of Application No. 09184600. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

15. Claims 25-43 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-59 of U.S. Patent No. 5,553,864. Although the conflicting claims are not identical, they are not patentably distinct from each other because: Sitrick claims a means for providing a predefined source which is known as presentation output of the audiovisual presentation. Additionally, although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to claim the method or system [device/apparatus] broader in order to obtain the most commercially viable form of invention or in order to obtain the broadest protection for invention for securing commercial viability. Essentially, the omitted language pertaining to the 'analyzing the presentation output associated with the selected portion' limited the invention and thus by

omitting the language, a broader form of invention is claimed which secures broader protection for commercial viability.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 25-28, 33-37 and 42-43 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bloch et al (4688105).

18. Claims 25-27, 33-36 and 42-43 are rejected under 35 U.S.C. 102(a) as being anticipated by applicants background or admitted prior art. Background of specification discloses incorporation of audience members into old video clips teaching (3:12-24) claimed invention, as broadly claimed.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

21. Claims 29-32 and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloch et al (4688105). Bloch discloses a video recording system for a user to 'interact' with a prerecorded video sequence of any sort while the interaction is itself being recorded (2:42-68) such that the user may appear in certain scenes and not appear in others (2:3-29) disclosing claimed invention, as broadly claimed, except 'transforming... content' (clms 29 and 38), 'scaling, ... filtering' (clms 30 and 39), 'graphical modification... content' (clms 31 and 40), 'morphing... color-correction' (clms 32 and 41). Scaling or filtering an image and color correction of an image such as by tinting or by adjusting hue are extremely well known techniques in image processing for film, movie, advertising and video for transforming image content or graphical modification of the image content so as to improve the blending of an image into the presentation. Therefore, it would have been obvious to an artisan at the time the invention was made to add transforming the user image content, scaling or filtering, graphical modification of user image content and tinting or adjusting hue or color-correction as well known image processing techniques to Bloch's recording system so as to improve the blending of the image into a presentation.

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Conclusion

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is (703) 308-0785. The examiner can normally be reached on T-F from 0700 to 1700. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Valencia Martin Wallace, can be reached on (703) 308-4119. The fax phone number for this Group is (703) 305-3580. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.



M. Sager
Primary Examiner
June 13, 2001